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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,394	12/12/2003	Charles Roderick Jenkins	57.0517 US NP	9752

7590 05/02/2005

Intellectual Property Law Department  
Schlumberger-Doll Research  
36 Old Quarry Rd  
Ridgefield, CT 06877

EXAMINER
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MCELHENY JR, DONALD E

ART UNIT	PAPER NUMBER
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2857

DATE MAILED: 05/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/734,394

Applicant(s)

JENKINS ET AL.

Examiner

Donald E. McElheny, Jr.

Art Unit

2857

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12-12-03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3-15-04, 11-24-04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

1. The disclosure is objected to because of the following informalities:

The abstract of the disclosure is objected to because it is over 150 words in length. Correction is required. See MPEP § 608.01(b).

The references throughout the written specification to US Applications should be updated to their current US Patent Numbers or Application Numbers.

Appropriate correction is required.

2. The IDS submissions received on 03/15/04 and 11/24/04 have been made of record. See the attached copies of form PTO-1449.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
5. Claims 1-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aronstam et al. ((6,443,228 B1).

Though this reference does not use the same terminology as the instant applicants, the claimed concepts are nevertheless taught or of such equivalent nature to be considered not involving the concept of invention. For example, "vessels" are met by the deployed flowable devices that identification has been assigned to them before deployment. Aronstam et al. teach that the devices may make use of biological, mechanical, as well as electric devices that carry whatever information is desired to be associated with the device and what it may be used for its monitoring purposes, and that powered and non-powered type modes of operating the devices may be used. Thus claimed features such as "signal information affixed to the vessels" is considered fully met, or at least full equivalents, in the teachings of this reference; and note that applicants' claimed phrase appears to be an oxymoron, as how can a "signal information" be "affixed to the vessels". Also note the phrase "at least one of three or more" is considered by one condition, but the reference teaches that any number of wellbore conditions may be monitored and transferred or derived by the flowable devices.

Limitations such as found in claim 8 that "the vessels are sealed in a non conductive medium" are met by teachings in the variations in the encapsulating materials that may used.

Variations in the shape of the "vessel" are either explicitly taught or by the reference's teaching and supplied motivation to vary such device's shape and size to accommodate the properties necessary to flow through (or even stick at select points) in

the particular borehole materials of the downhole environment. Nor is applicants' specification seen to assign criticality nor invention to such features.

The remaining claimed features are deemed readily apparent to one of ordinary skill in the art.

6. The remaining prior art cited is pertinent to the claimed invention as also meeting part or all the claims. Note the variations in teachings that the "vessels" that are deployed can be of mechanical identification codes/markers to electronic in nature. They also teach variations in size and shape that also meet the variations in applicants' claims and specification; they teach that size variation may down to micro size so as to enable the device to pass through the desired material it is desired to be deployed into or pass through.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald McElheny, Jr. whose telephone number is 571-272-2218. The examiner can normally be reached on Monday-Thursday from 7:30 to 4:00.

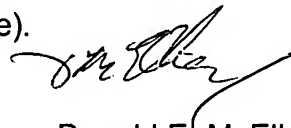
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoff Marc, can be reached on weekdays at telephone number 571-272-2216. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Donald E. McElheny, Jr.  
Primary Examiner  
Art Unit 2857